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10/033,401	12/26/2001	Scott A. Rosenberg	03-380-C	1472

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/033,401	ROSENBERG, SCOTT A.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7-10,12,13,20,21,23,24 and 26-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7-10,12,13,20,21,23,24 and 26-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to the paper(s) filed 12/17/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Chen et al (US7039933).**

4. Regarding claims 1, 20, 21, 26-28, 33, 34, Barton teaches a DVR (connected to a display device of a TV) with software that enables a user to select (during a first mode where figure 2's menu of pre-recorded programs is offered on the screen) a program for requested playback. Barton teaches a bookending function which can insert and play advertising before the user-selected, pre-recorded program is played. The bookending function also may play advertising after the program playback [abstract, 0014]. Both the beginning and end of the requested program content are taken to represent detections of a mode change and trigger obtaining/determination of an appropriate advertisement. Regarding the claimed feature that the advertising is displayed along with the video of the modes, it is unstated whether or not there is any visual overlap from the 1st mode (the menu) into the ad or whether or not there is any visual overlap out of the ad into the

2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (menu),...advertising...2nd mode (the requested program). Chen et al teaches that it is well known for displayed TV programming to include enhanced effects for the inclusion of advertisements. Specifically, Chen et al teaches that advertising enhancements may be displayed in a manner such that graphical and information (advertising) may be shown on the screen at the same time as the video program. Chen et al mentions that the advertising may overlay the video program or may opaquely cover a part of the program or may be transparent or semi-transparent; each of these provides teachings for displaying ads on the screen at the same time as non-advertising content. The advertising enhancement may also be shown next to a shrunken-down version of the content or the advertising may be shown on the screen after the program has been blanked out. Given the wide variety of techniques for displaying the advertising enhancements, it would have been obvious to one of ordinary skill at the time of the invention to have to have shown the triggered advertising of Barton in any of such manners for various effects, each of which provide ad content on the screen at the same time as the 1st and 2nd mode. It would have been obvious to one of ordinary skill at the time of the invention to have overlaid (for example) the ad over the menu as the menu disappears. Likewise, it would have been obvious to one of ordinary skill at the time of the invention for the end of the advertising to be shown as overlaid as the beginning of the requested show started.

5. Regarding claims 7-10, 13, Barton teaches that the ads are pre-stored on the device and that they can be selected on the basis of the viewer's preferences and

personal information [0015]. This is taken to provide a real-time and dynamic selection of ads based upon previously collected user information. Claim 10's "context information" is quite broad and could be met by virtually any information used for the bookend feature: the context that there is a transition to the start of a requested program, the context that there is a transition from the end a requested program, the context that the ads are targeted to the audience that the viewer is a part of [0015], the context of the genre, etc. The bookend programming/functionality [fig 9: 904] is taken to provide an ad placement engine.

6. Regarding claim 12, while any moving video content can be taken to be animation (i.e. simple motion), Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for Kellogg's Rice Krispies ™. It would have been obvious to one of ordinary skill at the time of the invention to have provided at least some of the advertisements of Barton as animations in a manner as well known.

7. Regarding claim 23, Chen et al's graphical enhancements (icons, banners, etc.) are taken to include still frames which are replicated so as to fill the desired screen display time.

8. Regarding claim 24, shrinking of the content and providing an adjacent advertisement area is taken to provide a "mini-ad" that is displayed along with video.

9. Regarding claim 31, Barton teaches downloading of the ads from a server [0049]. They are then stored obtained from memory when needed for display.

10. **Claims 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Chen et al (US7039933) and Borchardt et al (US5272525).**

11. Regarding claims 29, 30, Barton does not specify how the display device is connected to the DVR, however Borchardt et al describes typical connections between video sources hardware and TV displays as being wired [1:20-27] or as wireless transmissions [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have connected the DVR hardware of Barton in any such known manner.

12. **Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Chen et al (US7039933) and Klug (US2003/0195797).**

13. Regarding claim 32, Barton teaches targeting advertising to a user's preferences such as types of programming (e.g. sci-fi), but does not explicitly teach the use of a program title. Klug teaches targeted advertising to television programming and teaches that the programs title can be used as a basis to determine appropriate advertising [0032]. It would have been obvious to one of ordinary skill at the time of the invention to have used such title-based targeting with the invention of Barton in order to provide relevant advertising to the viewer.

14. **Claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, 34 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice.**

15. Regarding claims 1, 20, 21, 24, 26-28, 33, 34, Barton teaches a DVR (connected to a display device of a TV) with software that enables a user to select (during a first mode where figure 2's menu of pre-recorded programs is offered on the screen) a program for requested playback. Barton teaches a bookending function which can insert and play advertising before the user-selected, pre-recorded program is played. The bookending function also may play advertising after the program playback [abstract, 0014]. Both the beginning and end of the requested program content are taken to represent detections of a mode change and trigger obtaining/determination of an appropriate advertisement. Regarding the claimed feature that the advertising is displayed along with the video of the modes, it is unstated whether or not there is any visual overlap from the 1st mode (the menu) into the ad or whether or not there is any visual overlap out of the ad into the 2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (menu),…advertising…2nd mode (the requested program). Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. Some typical video transitions were called: wipe, dissolve, fade, etc., whereby these techniques help smooth or create fanciful transitions between different video portions. These transitions also provide at least for a limited time a visual overlap of two adjoining video sections. It would have been obvious to one of ordinary skill at the time of the invention to have

provided any of such well known transitions between the "modes" of Barton (menu transitions into the ad; the ad transitions into the selected program). By doing so, the end of the menu visuals would be mixed (i.e. on the screen at the same time) with the beginning of the advertising visuals. Likewise, the end of the advertising content would be mixed on screen with the start of the selected program. Official Notice is also taken that advertising has typically been accomplished with a "crawl", a scrolling ticker, a transparent banner, or overlaid still text all of which are taken to provide a "mini ad" and each of which would have been obvious. When overlaid ad text for example does not cover every pixel on the display, it may be considered to be a "mini ad" as well.

16. Regarding claims 7-10, 13, Barton teaches that the ads are pre-stored on the device and that they can be selected on the basis of the viewer's preferences and personal information [0015]. This is taken to provide a real-time and dynamic selection of ads based upon previously collected user information. Claim 10's "context information" is quite broad and could be met by virtually any information used for the bookend feature: the context that there is a transition to the start of a requested program, the context that there is a transition from the end a requested program, the context that the ads are targeted to the audience that the viewer is a part of [0015], the context of the genre, etc. The bookend programming/functionality [fig 9: 904] is taken to provide an ad placement engine.

17. Regarding claim 12, while any moving video content can be taken to be animation (i.e. simple motion), Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for

Kellogg's Rice Krispies ™. It would have been obvious to one of ordinary skill at the time of the invention to have provided at least some of the advertisements of Barton as animations in a manner as well known.

18. Regarding claim 23, the well known overlaid, still text is taken to include still frames which are replicated so as to fill the desired screen display time.

19. Regarding claim 31, Barton teaches downloading of the ads from a server [0049]. They are then stored obtained from memory when needed for display.

20. **Claims 29, 30 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Borchardt et al (US5272525).**

21. Regarding claims 29, 30, Barton does not specify how the display device is connected to the DVR, however Borchardt et al describes typical connections between video sources hardware and TV displays as being wired [1:20-27] or as wireless transmissions [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have connected the DVR hardware of Barton in any such known manner.

22. **Claim 32 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Klug (US2003/0195797).**

23. Regarding claim 32, Barton teaches targeting advertising to a user's preferences such as types of programming (e.g. sci-fi), but does not explicitly teach the use of a program title. Klug teaches targeted advertising to television programming and teaches that the programs title can be used as a basis to determine appropriate advertising [0032]. It would have been obvious to one of ordinary skill at the time of the invention to have used such title-based targeting with the invention of Barton in order to provide relevant advertising to the viewer.

Response to Arguments

24. Applicant argues Barton and Chen when combines fail to provide the claimed features of providing a interface menu on the screen at the same time as the ad. While Chen teaches overlaying of ads in a broadcast, one of ordinary skill would find it obvious for the advertising of Barton (which is locally stored on the DVR and inserted as directed by the DVR and *when directed* by the DVR) to be bookended using such overlaying techniques. This would provide overlaying of an ad with a menu as well as overlaying advertising with the beginning of the requested content playback.

25. Applicant argues that the examiner has not made a proper prima facie case of obviousness. Examiner disagrees and believes that the rejection set forth in the action is proper.

26. Applicant argues that that he official notices taken were improper because applicant believed hindsight was used. It is a given that the official notices were taken because it was believed that the concepts were notoriously well known *at the time of the*

invention. The examiner has not forgotten his duty to examine this case with respect to the evidence as a whole at the time of the invention. Applicant's have not presented a seasonable challenge to the takings of official notice.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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jdc